

No. 18539

IN THE

United States Court of Appeals

FOR THE NINTH CIRCUIT

FROMBERG, INC., a corporation,

Plaintiff and Appellant,
vs.

GROSS MANUFACTURING COMPANY, INC., a corporation,

Defendant and Appellee.

BRIEF OF DEFENDANT-APPELLEE THE
GROSS MANUFACTURING COMPANY.

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TOPICAL INDEX

	Page
Jurisdictional statement	1
Introduction	1
Statement of the case	2
Summary of argument	4
Argument	5
I.	
There are no genuine issues of any material fact concerning the question of infringement	5
II.	
The District Court's Memorandum Opinion and Findings of Fact serve the important function of advising this court of the basis of the District Court's judgment	7
III.	
Neither contributory infringement nor active inducement of infringement can exist unless there is direct infringement	12
IV.	
The District Court correctly held that there is no infringement in the replacement of the unpatented rubber plug in the Fromberg cartridge ..	14
V.	
The intention of the patentee as to how the patented device is to be used is not a proper test for infringement	26
Conclusion	32

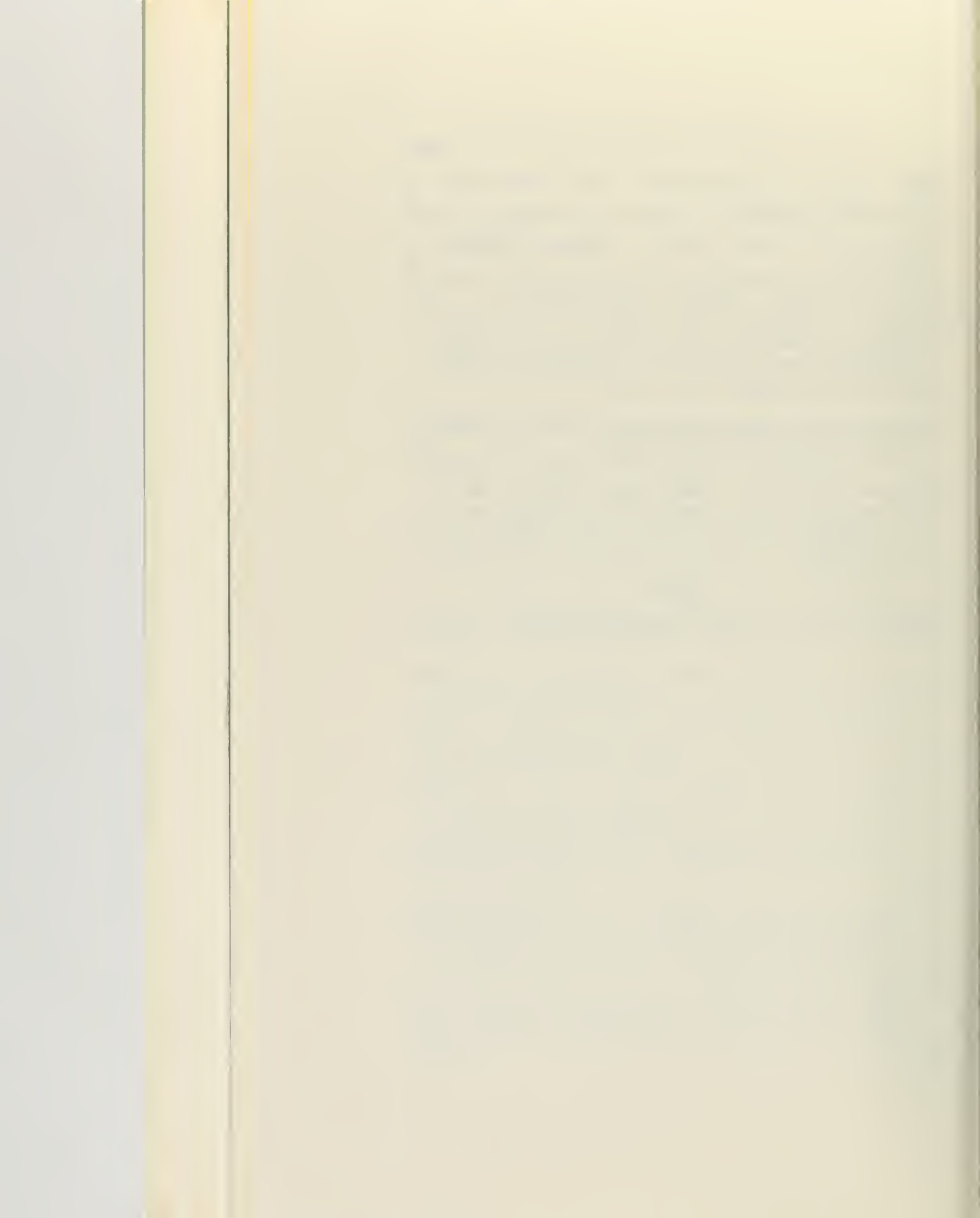
TABLE OF AUTHORITIES CITED

Cases	Page
Allen v. Radio Corporation of America, 47 Fed. Supp. 244	6
American Cotton Tie Co. v. Simmons, 106 U. S. 89, 1 S. Ct. 52, 27 L. Ed. 79.....	22, 24, 25, 26, 30
Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U. S. 336, 81 S. Ct. 599, 5 L. Ed. 2d 592	12, 15, 17, 19, 23, 26, 27, 29, 31
Bank of China v. Wells Fargo Bank & Union Trust Co., 104 Fed. Supp. 59, aff'd 209 F. 2d 467	10
Dana Perfumes, Inc. v. Mullica, 268 F. 2d 936	7
Fromberg, Inc. v. Thornhill, 315 F. 2d 407.....	28, 29, 30, 31
Green v. Electric Vacuum Cleaner Co., 132 F. 2d 312	25
Henry v. A. B. Dick Co., 224 U. S. 1, 32 S. Ct. 364, 56 L. Ed. 645	25
Heyer v. Duplicator Mfg. Co., 263 U. S. 99, 44 S. Ct. 31, 68 L. Ed. 189	23
Lindsey v. Leavy, 149 F. 2d 899, cert. den. 326 U. S. 783, 90 L. Ed. 474	7
Micromatic Hone Corp. v. Mid-West Abrasive Co. 177 F. 2d 934	28
Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co., 152 U. S. 425, 38 L. Ed. 500.....	13, 19, 20, 21, 22, 31
Motion Picture Patents Co. v. Universal Film Mfg. Co., 243 U. S. 502, 37 S. Ct. 416, 61 L. Ed. 871	26

	Page
Neff Instrument Corporation v. Cohu Electronics, Inc., 269 F. 2d 668	8
New and Used Auto Sales v. Hansen, 245 F. 2d 951	8
Park-In-Theatres v. Perkins, 190 F. 2d 137	6
Steigleder v. Eberhard Faber Pencil Co. et al., 176 F. 2d 604, cert. den. 338 U. S. 893, 94 L. Ed. 590, 70 S. Ct. 494.....	6
United States v. Univis Lens Co., 316 U. S. 241, 62 S. Ct. 1088, 86 L. Ed. 1408	26
Vermont Slate Co. v. Tatko Bros., 233 F. 2d 9, cert. den. 352 U. S. 917, 77 S. Ct. 216, 1 L. Ed. 2d 123	2

Rules

Federal Rules of Civil Procedure, Rule 56	8
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Jurisdictional Statement.

Defendant-appellee concurs in the jurisdictional statement appearing in Plaintiff-appellant's Brief.

Introduction.

The only issue concerning infringement of the patent in suit is a question of law, that is, whether or not an unpatented component (a rubber plug) may be replaced in the durable component (a metal shell) of the claimed combination without infringement. The District Court, on the basis of facts which are not disputed, granted a summary judgment declaring that the patent in suit was not infringed. On the question

of infringement of the patent in suit, no genuine issue of material facts exists.

“Summary judgment represents a most useful legal invention to save time and expense, by the avoidance of a trial, when there exists no material fact-issues. It may well be that, in a patent case, a judge should exercise unusual caution in granting a summary judgment. But there are patent cases where it would be an absurd waste of time and effort to deny such a judgment. *This is such a case.* (Italics added.)

Vermont Slate Co. v. Tatko Bros. (2nd Cir., 1956), 233 F. 2d 9, 10, cert. den. 352 U. S. 917, 77 S. Ct. 216; 1 L. Ed. 2d 123.

Statement of the Case.

The plaintiff-appellant manufactures and sells tire repair cartridges consisting of an elongated metal shell and a cylindrical rubber plug compressed within the shell as is described and claimed by the patent in suit No. 2,828,791. [Exs. A, B, C, D and P.] The rubber plug as well as the shell are unpatented components of the combination covered by the claims of the patent in suit. [Ex. P.] The purpose of the tubular metal shell of the cartridge sold by the plaintiff and as described and claimed in the patent is to dispense or install the rubber plug positioned therein into an opening in a tire to repair the same. As stated by the inventor, Aaron J. Fromberg, in the patent in suit:

“The object of this invention is, therefore, to provide means for installing a stem of resilient material in an opening through a motor vehicle tire

with the stem extended through the opening in the tire in which the stem is inserted by a rigid member. . . .” [Ex. P., Col. 1, lines 58-61.]

The rubber plug or stem is ejected from the tubular metal shell into the opening in the tire by an applicator such as the device 20 illustrated in the patent in suit. [Ex. P.] The tubular metal shell of the tire repair cartridge is capable of inserting many of the rubber plugs into puncture holes in tires. It is only necessary to place another rubber plug into the empty metal shell sold by the plaintiff-appellant to enable the shell to be used again to repair a tire. [R. 11, 12.]

The tire repair cartridges sold by the plaintiff-appellant do not carry any notice restriction which informs the purchaser that he may use the metal shell only once. [Exs. A, B, C and D.]

The defendant-appellee manufactures and sells tire repair kits consisting of one of the plaintiff’s cartridges [Ex. A] ready for use and 20 or more unpatented rubber tire repair plugs [Ex. E] adapted for refilling or reloading the empty metal cartridge shells. The defendant-appellee teaches its customers that its rubber tire repair plugs may be used to reload or refill the rubber tire repair cartridges sold by plaintiff. [Ex. M.] Thus, the tire repairman in purchasing defendant’s kit need not purchase a new metal cartridge shell for each unpatented rubber plug that is dispensed or installed into a tire to repair a leak.

The defendant has not manufactured any metal shells of the type referred to in the patent in suit. [R. 11.]

This suit was filed on June 6, 1962 charging the defendant with infringement, contributory infringement and active inducement of infringement of the patent in suit. The District Court granted defendant-appellee's motion for summary judgment based on the undisputed facts as set forth in the affidavits and the exhibits submitted therewith on October 24, 1962. [R. 23-25.] The District Court later entered Findings of Fact, Conclusions of Law and Judgment as prepared by the defendant's counsel on December 5, 1962 [R. 27-32] and plaintiff-appellant filed a notice of appeal to this Court on January 3, 1963.

Summary of Argument.

There are no genuine issues of any material fact concerning the question of infringement. On the basis of the undisputed facts the District Court correctly held that there is no infringement in the replacement of the spent unpatented rubber plug in the metal shell of the patented tire repair cartridge sold by plaintiff-appellant.

The Supreme Court has steadfastly refused to extend the patent monopoly to cover and thereby to restrain trade in unpatented components of a patented combination. A patentee is entitled only to a monopoly on the totality of the elements in the claims and no element, separately viewed, is entitled to the protection of his patent.

The law is crystal clear that an owner of the patented tire repair cartridge may replace the spent rubber plug to maintain the use of the whole combination without being liable for infringement.

ARGUMENT.

I.

There Are No Genuine Issues of Any Material Fact Concerning the Question of Infringement.

The nature of the patented tire repair cartridge, that is the tubular metal shell, and the cylindrical rubber plug compressed therein was before the trial court and is before this Court as a physical exhibit. [Exs. A, B, C and D.] The affidavit of Mr. W. M. Anderson clearly establishes that the shell of the tire repair cartridge sold by the plaintiff-appellant is capable of inserting many of the unpatented expendable rubber plugs into puncture holes in tires. [R. 11.] The plaintiff-appellant did not dispute this fact. Instead of questioning this obvious fact, the plaintiff-appellant's president T. E. Jordan [R. 19-20] merely stated that “. . . the shell portion of a Fromberg rivet is designed for a single use and to reclaim such shells and refill them for reliable operation is not economically feasible.” [R. 20.] This statement is in complete agreement with the fact that the tubular metal shell of the Fromberg cartridge is capable of inserting many tire repair plugs into tires. The present litigation would not even exist if the Fromberg cartridge could not be reloaded with new unpatented rubber plugs. Whether or not it is economically feasible for the tire repairman to insert a new rubber plug is, of course, something for the tire repairman to decide for himself and is not relevant to the issues of infringement.

There is no issue of fact in this case of defendant-appellee's reclaiming of the empty Fromberg shells. In the absence of any disputed issues of fact, the Court is authorized by Rule 56 of the Federal Rules of Civil Procedure to decide the case as a matter of law.

Park-In-Theatres v. Perkins (9th Cir., 1951),
190 F. 2d 137;

Allen v. Radio Corporation of America (D. C.
Del., 1942), 47 Fed. Supp. 244.

In *Steigleder v. Eberhard Faber Pencil Co. et al.* (1st Cir., 1949), 176 F. 2d 604, 605, cert. den. 338 U. S. 893, 94 L. Ed. 590, 70 S. Ct. 494, the Court held:

“Summary judgment under Rule 56(c), Federal Rules of Civil Procedure, 28 U.S.C.A., is sometimes appropriate in a patent case, at least on the issue of infringement. Where it is apparent that there is no genuine issue of fact bearing on infringement, and the structure and mode of operation of the accused device are such that they may be readily comprehended by the court, and compared with the invention described and claimed in the patent, without the need of technical explanation by the testimony of expert witnesses, then the court, if satisfied that there is no infringement, should give summary judgment for the defendant, instead of subjecting the parties to the expense of a trial. . . .”

The District Court properly granted defendant's motion for Summary Judgment since there are no issues of material fact concerning infringement.

II.

The District Court's Memorandum Opinion and Findings of Fact Serve the Important Function of Advising This Court of the Basis of the District Court's Judgment.

This Court has observed that findings of fact and conclusions of law are unnecessary in granting a summary judgment since such a judgment means there are no material facts in dispute. However, such findings have been held to be permissible for the purpose of providing a good summary of the District Court's Judgment.

Lindsey v. Leavy (9th Cir., 1945), 149 F. 2d 899, cert. den. 326 U. S. 783, 90 L. Ed. 474;

Dana Perfumes, Inc. v. Mullica (9th Cir., 1959), 268 F. 2d 936.

In the Memorandum Opinion the District Court found:

“The plaintiff manufactures and sells tire repair cartridges consisting of an elongated shell, somewhat like a rifle shell but open on both ends, and a cylindrical rubber plug compressed within the shell. It is the purpose of this shell, when used with an applicator, to dispense the rubber plug therein contained into an opening in the tire to repair the same. In order to re-use the metal shell it is only necessary to place therein another rubber plug. Neither the shell nor the rubber plug are patentable components, but it is the combination which is claimed as a subject of the patent in suit.

“The defendant manufactures and sells rubber repair plugs adaptable for reloading plaintiff’s metal shells and teaches its customers that its plugs may be used to reload plaintiff’s empty shells by following simple instructions furnished by defendant. Defendant also purchases plaintiff’s cartridges and sells tire repair kits consisting of one of plaintiff’s cartridges, ready for use, and 20 or more rubber plugs of defendant’s manufacture, furnishing therewith instructions as to how to refill plaintiff’s shells.

“Upon these facts plaintiff sues for infringement of its patent and the matter comes before us on defendant’s motion for summary judgment. Defendant urges that all the facts hereinabove stated are undisputed and that they establish non-infringement. With this conclusion we agree.” [R. 23, 24.]

This finding clearly states that there is no genuine issue of any material fact necessary to the consideration and determination of the motion for summary judgment. This finding is clearly supported by the affidavits of W. M. Anderson [R. 10] and T. E. Jordan [R. 19], the patent in suit [Ex. P] and the physical Exhibits A, B, C, D, E, F, G, H, J, K, L and M which were before the District Court. This finding clearly meets the requirements of Rule 56 of the Federal Rules of Civil Procedure and the decisions of this Court in *New and Used Auto Sales v. Hansen* (9th Cir., 1957) 245 F. 2d 951; *Neff Instrument Corporation v. Cohu Electronics, Inc.* (9th Cir., 1959), 269 F. 2d 668.

Finding of Fact No. 5 is as follows:

“5. U. S. Letters Patent No. 2,828,791, the patent in suit, is directed to the combination of two components, that is, an elongated rigid shell (having an outwardly flared portion at one end and a beveled outer surface on the other end) and a cylindrical element or plug of resilient material such as rubber positioned within the shell in a contracted state. The rubber plug as well as the shell are unpatented components of the combination described by the claims of the patent in suit.”
[R. 28]

Finding No. 5 merely sets out the combination that is covered by the claims of the patent in suit and the undisputed fact that both the rubber plug and the shell are unpatented components.

“7. In use of the tire repair cartridge disclosed by the patent in suit, the outwardly flared portion of the shell is gripped in an applicator, as shown in Fig. 1 of the patent, and the shell is forced through an opening in a tire. The applicator contains a plunger which passes downwardly through the tubular shell as the shell is drawn outwardly through the opening in the tire so that the stem is extruded from the shell leaving the stem to seal the opening within the tire. The empty shell may then be reloaded by placing another rubber plug therein and the tire repairing procedure repeated.” [R. 28, 29.]

Finding 7 sets out the procedure for repairing an opening in a tire with the patented tire repair cartridge. These facts are not disputed.

“9. It is the purpose of the tubular metal shell of the tire repair cartridge sold by the plaintiff, and as disclosed and claimed in the patent in suit, when used with an applicator, to dispense the rubber plug positioned therein into an opening in a tire to repair the same.” [R. 29.]

Finding 9 points out that the metal shell when used with an applicator dispenses the rubber plug into an opening in a tire. The facts concerning the use of the metal shell and rubber plug with an applicator to repair an opening in a tire are set forth in the patent in suit and are not disputed. However, the plaintiff-appellant objects to the use of the term “dispense” and would apparently prefer to describe the shell as “installing” the rubber plug into the opening in a tire instead of “dispensing” the plug. The argument is obviously one based on semantics. The fact is undisputed that the rubber plug is dispensed from or pushed out of the shell to repair a tire thereby leaving the shell available for refilling with a new unpatented rubber plug. Where only the legal effect of factual occurrences and conclusions to be drawn from them are in dispute, there is no genuine issue of material fact and the cause may be determined on a motion for summary judgment.

Bank of China v. Wells Fargo Bank & Union Trust Co. (D. C. Cal., 1952), 104 Fed. Supp. 59, 63, affirmed (9th Cir., 1953), 209 F. 2d 467.

“11. The rubber plug positioned within the shell of plaintiff’s tire repair cartridge has only a temporary period of usefulness in the claimed combination and must be replaced after each repair is made with the shell for the continued utilization of the claimed combination as a whole.” [R. 29.]

The plaintiff-appellant does not dispute the facts set out in Finding 11 but instead contends that the District Court resolved issues of fact in concluding “. . . the rubber cylinder must be replaced to utilize the combination as a whole.” (Appellant’s Br. p. 21.)

Obviously once the rubber plug has been removed from the shell it must be replaced if the tire repair cartridge is to have continued utilization for repairing additional tires. The plaintiff-appellant’s contention of an error on the part of the District Court is not based on an error in resolving a factual issue at all but is based on an issue of law. This issue of law is the heart of the entire controversy, that is, does the owner of one of plaintiff’s tire repair cartridges have the right to replace the spent rubber plug so that the combination of the shell and plug may be used again or must he throw the metal shell away after he has made only one repair.

All of the foregoing findings find support in the record before the District Court. They explain the Court’s conclusion and show why infringement of the patent in suit does not exist as a matter of law.

III.

Neither Contributory Infringement nor Active Inducement of Infringement Can Exist Unless There Is Direct Infringement.

The plaintiff-appellant contends that the defendant-appellee is guilty of direct infringement by placing a new unpatented rubber plug into a Fromberg cartridge shell; that defendant-appellee is guilty of actively inducing infringement by informing customers and potential customers that the empty Fromberg metal shells may be reloaded by unpatented rubber plugs of defendant-appellee's manufacture; and that defendant-appellee is guilty of contributory infringement for selling the unpatented rubber plugs and a cartridge holder [Ex. J] for enabling the ultimate user or the tire repair man to quickly reload the empty Fromberg metal shells with rubber plugs of defendant's manufacture.

It is axiomatic that the defendant-appellee cannot contribute to infringement or actively induce infringement unless the act of refilling the empty Fromberg cartridge shell with a new rubber plug is of itself a direct infringement. One cannot actively induce or contribute to a non-existent infringement.

The Supreme Court in restating this fundamental axiom in *Aro Mfg. Co. v. Convertible Top Replacement Co.* (1961), 365 U. S. 336, 341, 81 S. Ct. 599, 5 L. Ed. 2d 592, 596, 597 held:

“. . . It is admitted that petitioners know that the purchasers intend to use the fabric for replacement purposes on automobile convertible tops which are covered by the claims of respondent's combination patent, and such manufacture and sale

with that knowledge might well constitute contributory infringement under § 271(c), if, but only if, such a replacement by the purchaser himself would in itself constitute a *direct* infringement under § 271(a), for it is settled that if there is no *direct* infringement of a patent there can be no *contributory* infringement. . . . It is plain that § 271(c)—a part of the Patent Code enacted in 1952—made no change in the fundamental precept that there can be no contributory infringement in the absence of a direct infringement. . . .”

Clearly the resale by defendant-appellee of Fromberg cartridges including the shell and plug as manufactured by the plaintiff-appellant is not an infringement since by the original sale of the patentee the cartridges passed out of the limits of the patent monopoly and might be used or resold by anyone without infringement of the patent.

Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co. (1894), 152 U. S. 425, 432-433, 38 L. Ed. 500, 503.

Also the sale of the rubber repair plug and the cartridge holder does not constitute direct infringement since neither element is separately covered by the patent in suit.

The sole issue is whether or not the reloading of an empty Fromberg metal shell with a new unpatented rubber plug of defendant-appellee's manufacture by the owner or tire repairman constitutes direct infringement.

IV.

The District Court Correctly Held That There Is No Infringement in the Replacement of the Unpatented Rubber Plug in the Fromberg Cartridge.

The District Court found that it was the purpose of the metal cartridge shell when used with an applicator to dispense the rubber plug contained therein into an opening in a tire to repair the same and that in order to re-use the metal shell it was only necessary to place therein another rubber plug. After finding such undisputed facts, the District Court held:

“ . . . There are, no doubt, many cases holding that where the manufacture and sale of a single element of a patented combination with the intent that it shall be used with the other elements and so complete the combination, is an infringement if the use of the added elements constitutes a ‘reconstruction’ of the original device, but not, if it constitutes only a ‘repair.’ *Morgan Envelope Company v. Albany Paper Company*, 152 U. S. 425. But as pointed out in the *Morgan Envelope* case, these cases have no application to one where the element made by the alleged infringer is an article of manufacture, perishable in its nature, which it is the object of the mechanism to deliver, and which must be renewed periodically whenever the device is put to use. Although it cannot be said in the instant case that the rubber plug is perishable, it nevertheless has only a temporary use in the patentable combination.

“In *Aro Manufacturing Co. v. Convertible Top Replacement Co.*, 365 U. S. 336, 343, note 9, the Court stated: ‘*Morgan Envelope Co. v. Albany Paper Co.*, 152 U. S. 425, and *Heyer v. Duplicator Mfg. Co.*, 263 U. S. 100, held that an owner or licensee of a patented machine or combination does not infringe the patent by replacing an unpatented element of the combination which has only a *temporary period of usefulness* (emphasis ours), so that replacement is necessary for continued utilization of the machine or combination as a whole.’

“The plaintiff, having once sold its cartridge, is no longer entitled to the protection of its patent on the device sold, and the defendant, as a purchaser, may therefore without infringement replace, or advise others to replace, an unpatented component thereon with one of defendant’s own design and manufacture.” [R. 24, 25.]

The *Aro* case quoted from and relied on by the District Court is the most recent and authoritative holding of the Supreme Court of what constitutes a repair or a reconstruction of a patented combination. In the *Aro* case the plaintiff had a patent on the combination of a flexible top fabric, a supporting structure and a wiper mechanism for sealing the fabric against the side of the automobile body to keep out the rain. The defendant made fabric tops especially adapted for use in the patented structure and sold such tops knowing that the purchaser intended to use the fabric as a replacement on automobile convertible tops which were covered by the patent. The patentee urged that the

particular shape of the fabric top was the essence or very heart of the invention, that it was relatively expensive, relatively difficult to replace, that therefore, a new license had to be obtained and another royalty paid to the patentee when the top was replaced. The Court of Appeals for the First Circuit held that the owner of an automobile with the patented top would not rationally believe that the replacement of the expensive, long lasting top fabric (expected life span of three years) was a mere repair and thus that such replacement was a reconstruction and an infringement of the patent. The Supreme Court reversed in holding that:

“No element, not itself separately patented, that constitutes one of the elements of a combination patent is entitled to patent monopoly, however essential it may be to the patented combination and no matter how costly or difficult replacement may be. While there is language in some lower court opinions indicating that ‘repair’ or ‘reconstruction’ depends on a number of factors, it is significant that each of the three cases of this Court, cited for that proposition, holds that a license to use a patented combination includes the right ‘to preserve its fitness for use so far as it may be affected by wear or breakage.’ Leeds & Catlin Co. v. Victor Talking Mach. Co. 213 US 325, 336, 53 L. ed 816, 820, 29 S. Ct 503; Heyer v. Duplicator Mfg. Co. supra (263 US at 102); and Wilson v. Simpson, supra (US) 9 How at 123. *We hold that maintenance of the ‘use of the whole’ of the patented combination through replacement of a spent, unpatented element does not constitute reconstruction.*”

“The decisions of this Court require the conclusion that reconstruction of a patented entity, comprised of unpatented elements, is limited to such a true reconstruction of the entity as to ‘in fact make a new article,’ *United States v. Aluminum Co. of America*, supra (148 F 2d at 425), after the entity, *viewed as a whole*, has become spent. In order to call the monopoly, conferred by the patent grant, into play for a second time, it must, indeed, be a second creation of the patented entity, as for example, in *Cotton-Tie Co. v. Simmons*, 106 US 89, 27 L ed 79, 1 S Ct 52, supra. *Mere replacement of individual unpatented parts, one at a time, whether of the same part repeatedly or different parts successively, is no more than the lawful right of the owner to repair his property.* Measured by this test, the replacement of the fabric involved in this case must be characterized as permissible ‘repair,’ not ‘reconstruction.’” (Emphasis added.)

Aro Mfg. Co. v. Convertible Top Replacement Co., supra, 365 U. S. 336, 346, 5 L. Ed. 2d 592, 599.

The Supreme Court thus laid down the simple legal test that there is no reconstruction or infringement by the replacement of a spent unpatented part by an owner of the patented combination.

See the concurring opinion of Justice Black at 365 U. S., p. 361 and the dissenting opinion of Justices Harlan, Frankfurter and Stewart at 365 U. S., p. 375.

This test of permissible repair laid at rest many previous lower Court decisions where reconstruction

had been found on the basis of such factual issues as the importance or cost of the replaced part to the remainder, the ease or difficulty in making the replacement and the patentee's intention as to the use of the patented combination.

In setting out the narrow limits of the doctrine of reconstruction, the Court further stated:

“This Court's decisions specifically dealing with whether the replacement of an unpatented part, in a patented combination, that has worn out, been broken or *otherwise spent*, is permissible ‘repair’ or infringing ‘reconstruction,’ have steadfastly refused to extend the patent monopoly beyond the terms of the grant. *Wilson v Simpson* (US) 9 How 109, 13 L ed 66—doubtless the leading case in this Court that deals with the distinction—concerned a patented planing machine which included, as elements, certain cutting knives which normally wore out in a few months' use. The purchaser was held to have the right to replace those knives without the patentee's consent. . . . The Court explained that it is ‘the use of the whole’ of the combination which a purchaser buys, and that repair or replacement of the worn-out, damaged or destroyed part is but an exercise of the right ‘to give duration to that which he owns, or has a right to use as a whole.’ *Ibid.*⁹

(Footnote 9) “None of this Court's later decisions dealing with the distinctions between ‘repair’ and ‘reconstruction’ have added to the exposition made in *Wilson v Simpson* (US) *supra*, and that opinion has long been recognized as the Court's authoritative expression on the subject.

Morgan Envelope Co. v Albany Perforated Wrapping Paper Co. 152 US 425, 38 L ed 500, 14 S Ct 627, and Heyer v Duplicator Mfg. Co. 263 US 100, 68 L ed 189, 44 S Ct 31, held that an owner or licensee of a patented machine or combination does not infringe the patent by replacing an unpatented element of the combination which has only a temporary period of usefulness, so that replacement is necessary for continued utilization of the machine or combination as a whole. Those cases came clearly within the Wilson Case. American Cotton-Tie Co. v Simmons, 106 US 89, 27 L ed 79, 1 S Ct 52, the only other repair-reconstruction case decided by this Court since Wilson, *found infringement by one who bought up, as scrap metal, patented metal straps, used in tying cotton bales, after the straps had been used and severed (in unbinding the bales), and who then welded or otherwise reconnected the straps at the severed point and resold them for further use in baling cotton.* The case is distinguishable on its facts, and the fact that the *ties were marked 'Licensed to use once only,' was deemed of importance by the Court.* Cf. Henry v A. B. Dick Co. 224 US 1, 56 L. ed 645, 32 S Ct 364, Ann Cas 1913D 880." (Emphasis added.)

Aro Mfg. Co. v. Convertible Top Replacement Co., supra, 365 U. S. 336, 342, 343, 5 L. Ed. 2d 592, 597, 598.

The *Morgan Envelope Co.* case relied on in the *Aro* decision involved a fact situation almost identical to the case at bar, in which the plaintiff obtained a patent for the combination of a roll of toilet paper and

a dispensing mechanism for delivering the paper to the user. The Supreme Court held that there was no infringement or contributory infringement by the defendant in reselling the dispensing mechanism previously purchased from the patent owner and selling rolls of toilet paper for use in dispensing mechanisms previously sold by the patent owner.

In the *Morgan Envelope Co.* case the Court stated the real issue to be:

“The real question in this case is whether, conceding the combination of the oval roll with the fixture to be a valid combination, the sale of one element of such combination, with the intent that it shall be used with the other element, is an infringement. We are of opinion that it is not. There are doubtless many cases to the effect that the manufacture and sale of a single element of a combination, with intent that it shall be united to the other elements, and so complete the combination, is an infringement. *Saxe v. Hammond*, Holmes, 456; *Wallace v. Holmes*, 9 Blatchf. 65; *Barnes v. Strause*, 9 Blatchf. 553; *Schneider v. Pountney*, 21 Fed. Rep. 399. But we think these cases have no application to one *where the element made by the alleged infringer is an article of manufacture perishable in its nature, which it is the object of the mechanism to deliver, and which must be renewed periodically, whenever the device is put to use.* Of course, if the product itself is the subject of a valid patent, it would be an infringement of that patent to purchase such product of another than the patentee; but if the product be unpatentable, it is giving to the patentee

of the machine the benefit of a patent upon the product, by requiring such product to be bought of him. To repeat an illustration already put: If a log were an element of a patentable mechanism for sawing such log, it would, upon the construction claimed by the plaintiff, require the purchaser of the sawing device to buy his logs of the patentee of the mechanism, or subject himself to a charge of infringement. This exhibits not only the impossibility of this construction of the patent, but the difficulty of treating the paper as an element of the combination at all. In this view, *the distinction between repair and reconstruction becomes of no value, since the renewal of the paper is in a proper sense neither the one nor the other.*" (Emphasis added.)

Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co. (1894), 152 U. S. 425, 432, 433, 14 S. Ct. 627, 38 L. Ed. 500, 503.

In the case at bar the metal shell is used to deliver the rubber repair plugs into tires in the same manner that the dispenser mechanism in the *Morgan Envelope Co.* case was used to deliver toilet paper to the user. There is no infringement of the patent in suit in reloading the empty Fromberg metal cartridge shells with replacement plugs manufactured and sold by the defendant.

The plaintiff-appellant relies on the hypothetical case of the patented torpedo referred to in the *Morgan Envelope Co.* case in an attempt to show that the reloading the empty Fromberg metal cartridge shells is a reconstruction. The *Morgan Envelope Co.* case

in drawing a parallel to the case of *American Cotton Tie Co. v. Simmons* (1882), 106 U. S. 89, 1 S. Ct. 52, 27 L. Ed. 79, where the bands of the cotton bale ties were severed at the cotton mill, sold as scrap iron and then new bands were made by piecing together pieces of the old band stated:

“It is evident that the use of the tie was intended to be as complete a destruction as would be the explosion of a patented torpedo. In either case, the repair of the band or the refilling of the shell would be a practical rebuilding of the device.”

Morgan Envelope Co. v. Albany Perforated Wrapper Paper Co., *supra*, 152 U. S. 425, 429, 38 L. Ed. 500, 504.

The plaintiff-appellant interprets the Supreme Court's use of the term torpedo to refer to a rifle or other small arm cartridge in which the shell casing would remain reusable after the lead bullet was expelled. A torpedo is a well known submarine projectile and it is difficult to believe that the Supreme Court intended that the term torpedo refer to something other than what it is. A torpedo after explosion would leave the shell in bits and pieces which could be reclaimed and pieced together with other torpedo shell fragments to form a new shell as was done with the scrapped severed bands in the *American Cotton Tie* case. If the Supreme Court had intended to inform the general public that small arm cartridges could not be reloaded by placing a new lead bullet and powder therein without infringing a patent that might exist on the combination, the Supreme Court would not have referred

to a torpedo since it has long been a common practice in this country for gun owners to reload small arm cartridge shells.

The *Heyer v. Duplicator Mfg. Co.* case also relied on in the *Aro* decision involved a patent on a multiple copying machine which included as an element thereof a gelatine band of many feet in length. The gelatine band could be used for making hundreds of copies. The patentee sold the machine outright without attempting to impose any contractual obligations or restrictions on the use of the machine. The patentee contended that the gelatine band was an element of the combination claimed and could not be replaced except with the patentee's consent and that such replacement without his consent was infringement. With this contention the Seventh Circuit agreed; 284 Fed. 242 (1922). The Supreme Court reversed holding that:

“Since *Wilson v. Simpson*, 9 How. 109, 123, 13 L. ed. 66, 72, it has been the established law that a patentee has not ‘a more equitable right to force the disuse of the machine entirely, on account of the inoperativeness of a part of it, than the purchaser has to repair, who has, in the whole of it, a right of use.’ The owner, when he bought one of these machines, had a right to suppose that he was free to maintain it in use, without the further consent of the seller, for more than the sixty days in which the present gelatine might be used up. . . .”

Heyer v. Duplicator Mfg. Co. (1923), 263 U. S. 99, 101-102, 44 S. Ct. 31, 68 L. Ed. 189, 190.

The early decision of the Supreme Court in *American Cotton Tie* case upon which the plaintiff-appellant so heavily relies, involved a patent on a cotton bale tie including a buckle with a restrictive notice "Licensed to use once only" and a band of iron. The tie consisting of the buckle and band was purchased by a person desiring to use it to confine cotton in a bale and was placed around the bale at the plantation or at the cotton press. The bale of cotton including the tie was then sold to the cotton mill as a unit at so much per pound for the cotton and tie. The cotton mill owner (not the original purchaser) severed the band to process the cotton and sold the pieces of bands and buckles as scrap iron. The defendant purchased such scrap iron, straightened the old pieces of the bands by cold rolling, formed new bands by welding or riveting several pieces of the old bands together, cut the newly made bands into proper lengths and attached them to an old buckle. The newly made tie was then sold for use to confine new bales of cotton. The Supreme Court held that the remaking of the bands out of scrap metal and combining such bands with the used buckles which were stamped "Licensed to use only once" was an infringement and thus a reconstruction of the patented device.

In the *American Cotton Tie* case the patented combination had been rebuilt *de nova* from the ground up out of the scrap iron sold by the cotton mill owners.

“. . . (A) sale of scrap is a sale not to use but to destroy, and cannot be wrested into a sale of

the patented machines because the different parts could be picked up and put together out of it.”

Green v. Electric Vacuum Cleaner Co. (6th Cir., 1942), 132 F. 2d 312, 314 (citing the *American Cotton Tie* case).

The *American Cotton Tie* case is clearly distinguishable from the case at bar on its facts. In the first place, defendant-appellee does not purchase scrap cartridge shells and reload them. In the case at bar the purchaser of the patented combination, the tire repairman, keeps the empty metal shells and reloads the shells himself. In the second place, the metal cartridge shells in the case at bar are not rewelded or rebuilt to make a new shell but are reloaded in their original form. There is no rebuilding of the patented invention *de novo* from the ground up as there was in the *American Cotton Tie* case.

In one other material respect, the present case differs from the *American Cotton Tie* case, and that is the restrictive notice “Licensed to use only once” which was stamped on the buckles in the *American Cotton Tie* case. The purchasers of the buckles received the buckles subject to the limited license contained in the notice, that is, to have the buckle and band confine a bale for one time only and not for a longer time. In the case at bar, the patented tire repair cartridges are purchased without any restrictive notice and pass into the market place as ordinary articles of commerce free and clear of the patent monopoly.

Henry v. A. B. Dick Co. (1912), 224 U. S. 1, 37, 32 S. Ct. 364, 56 L. Ed. 645, 659;

Motion Picture Patents Co. v. Universal Film Mfg. Co. (1917), 243 U. S. 502, 37 S. Ct. 416, 61 L. Ed. 871;

United States v. Univis Lens Co. (1942), 316 U. S. 241, 62 S. Ct. 1088, 86 L. Ed. 1408.

The restrictive license notice stamped on the buckles in the *American Cotton Tie* case was deemed of importance by the Court in finding infringement or reconstruction as was stated by the majority opinion in the *Aro* case wherein the Court stated:

“The (Cotton Tie) case is distinguishable on its facts, and the fact that the ties were marked ‘Licensed to use once only,’ was deemed of importance by the Court. Cf. *Henry v. A. B. Dick Co.* 224 US 1, 56 L. Ed 645, 32 S. Ct. 364, Ann Cas 1913 D 880.” (Parenthesis added.)

Aro Mfg. Co. v. Convertible Top Replacement Co., *supra*, 365 U. S. 336, 349, 5 L. Ed. 2d 592, 597. (Footnote 9.)

V.

The Intention of the Patentee as to How the Patented Device Is to Be Used Is Not a Proper Test for Infringement.

The plaintiff-appellant places great reliance upon the contention that the patentee’s intention of how the tire repairman is to use the patented tire repair cartridge is determinative of the question of infringement. This test is clearly unrealistic and not supported by the law. In the concurring opinion of Justice Black in the *Aro* case it is stated:

“ . . . Deciding whether a patented article is ‘made’ (or reconstructed) does not depend on

whether an unpatented element of it is perishable, or how long some of the elements last, or what the patentee's or a purchaser's intentions were about them, . . ." 365 U. S., p. 354, 56 L. Ed. 2d, p. 604. (Parenthesis added.)

* * *

" . . . And surely the scope of a patent should never depend upon a psychoanalysis of the patentee's or purchaser's intentions, a test which can only confound confusion. The common sense of the whole matter is, as recognized in the Wilson Case and again in the opinion of the Court today, that in none but the most extraordinary case—difficult even to imagine—will a court ever have to invoke specially contrived evidentiary standards to determine whether there has actually been a new 'making' of the patented article." 365 U. S., p. 355, 5 L. Ed. 2d 604, 605.

* * *

" . . . Congress surely did not intend for it to be left within the sole discretion of the patent monopolist whether an unpatented component part will be separately available to the purchaser for replacement in the combination or whether, when that part wears out, the purchaser will be forced to replace a larger subcombination of the patented product or perhaps even the entire aggregation. . . ." 365 U. S., p. 360, 5 L. Ed. 2d 607.

Clearly, if the intention of the patentee were controlling as to the use of the patented invention after the patented invention had been sold the patent monopoly would be expanded many fold. In the *Aro* case

the patentee did not intend that the top fabric when worn out should be replaced without his consent. The test of the majority opinion in the *Aro* case is simply that the same part or different parts of a patented invention may be replaced from time to time by the owner without infringement regardless of the patentee's wishes or intentions. That is all that has occurred in the case at bar.

In *Micromatic Hone Corp. v. Mid-West Abrasive Co.* (6th Cir., 1949), 177 F. 2d 934, 937, the Court expressly rejected the argument that the patentee's intention in the design of an unpatented component so that it was cheaper to throw the component away than refill it with the perishable component was relevant in determining infringement or repair in stating:

“ . . . It also seems clear to us that while its low cost of manufacture warranted a purchaser in throwing it away after the initial stone was worn down, rather than returning it for a refill when the purchaser did not care to be bothered with such details, nevertheless, the metal stone holder was not expended or destroyed, but on the contrary, had a continued useful life and was available to the purchaser of it for refilling if he desired to do so rather than to throw it away . . .”.

The plaintiff-appellant relies on the Fifth Circuit decision of *Fromberg, Inc. v. Thornhill* (5th Cir., 1963), 315 F. 2d 407 as precedent for the “intention” test. In this case the Fifth Circuit held that the replacing of a rubber plug in the cartridge shell previously sold by the plaintiff-appellant, Fromberg, Inc., was a reconstruction and thus an infringement. In

arriving at this conclusion, the Court completely misconstrued the simple test laid down in the *Aro* case. Instead of applying the test set forth in the *Aro* decision, to wit:

“ . . . In order to call the monopoly, conferred by the patent grant, into play for a second time, it must, indeed, be a second creation of the patented entity, as for example, in *Cotton-Tie Co. v. Simmons*, 106 US 89, 27 L.ed 79, 1 S Ct. 52, *supra*. (Reclamation of scrapped parts.) Mere replacement of individual unpatented parts, one at a time, whether of the same part repeatedly or different parts successively, is no more than the lawful right of the owner to repair his property. . . .” (Parenthesis added.)

Aro Mfg. Co. v. Convertible Top Replacement Co., *supra*, 365 U. S. 336, 346, 5 L. Ed. 2d 592, 599.

The Fifth Circuit applied the test of “whether when sold by the patentee, it is reasonably contemplated that the device will be repeatedly used. . . .” *Fromberg, Inc. v. Thornhill*, *supra*, 315 F. 2d 407, 412. Using this vague and unrealistic test, the Fifth Circuit concluded that the Fromberg metal shell has a single shot function and purpose for a one-time use and therefore was licensed for one use only even though no such notice restriction appeared on the patented combination to advise the public of the patentee’s intention. This test would permit the patentee to determine when a purchaser is required to replace the entire com-

bination instead of only one unpatented element thereof without even notifying such a purchaser of this fact. What is to prevent the patentee from changing his mind as to how the patented device is to be used? What test should be applied to the purchaser that buys Fromberg cartridges for the purpose of reloading the shells with rubber plugs purchased on the open market? Is a statistical survey of the intention of the thousands or millions of buyers necessary to determine whether the replacement of an unpatented rubber plug is a reconstruction or a permissible repair? Should the scope of the patent depend upon a psychoanalysis of the patentee's or purchaser's intentions?

After determining that the Fromberg tire repair cartridge had a contemplated purpose of one use only even though the metal shell is capable of inserting many tire repair plugs into a tire, the Fifth Circuit stated that such facts bring the case precisely within the *American Cotton Tie* case. In arriving at this conclusion, the Court completely overlooked the determinative facts in the *American Cotton Tie* case, that is; (1) the remaking of the patented invention out of scrap parts; and (2) the fact that the buckles were stamped with the restrictive license notice that they could be used only once. The Court in the *Fromberg* case even went so far as to hold that:

“. . . Of course little reliance can be placed on the fact that the metal ties (in the Cotton Tie case) bore the legend 'Licensed to use once only.'”
(Parenthesis added.)

Fromberg, Inc. v. Thornhill, supra, 315 F. 2d 407, 413, Footnote 15.

This statement by the Fifth Circuit is in direct contradiction to the majority opinion in the *Aro* case where in the Court stated:

“ . . . the fact that the ties were marked ‘Licensed to use once only’ was deemed of importance by the Court. . . .”

Aro Mfg. Co. v. Convertible Top Replacement Co., *supra*, 365 U. S. 336, 343, 5 L. Ed. 2d 592, 598, Footnote 9.

The Fifth Circuit while recognizing the simple test of reconstruction as established in the *Aro* case “. . . does this really make a device? . . .” failed to apply it. *Fromberg v. Thornhill*, *supra*, 315 F. 2d 407, 412. Does the replacement of the cylindrical rubber plug in the Fromberg metal shell [Exs. A, B, C or D] make a new device when the replacement of the expensive, durable top fabric which was the very heart of the extremely successful Mackie-Dulck invention does not make a new device?

It is respectfully submitted that the Fifth Circuit decision in *Fromberg, Inc. v. Thornhill*, *supra*, applied the wrong legal test in finding that the reloading of a Fromberg shell with a new unpatented rubber plug by the tire repairman was a reconstruction of the patented combination instead of a permissible replacement of an unpatented element having only a temporary period of usefulness as set forth by the Supreme Court in the *Aro* and *Morgan Envelope Co.* cases.

